

**REMARKS**

Entry of the foregoing, and further and favorable reconsideration of the subject application are respectfully requested.

**Status of Claims**

By the present amendment, the priority claim in the specification has been amended to correct minor errors. Claims 78-92, added in the amendment filed May 12, 2010, have been canceled without prejudice or disclaimer to the subject matter contained therein. Claims 93-102 are pending. Claims 95 and 96 have been amended to depend from claims 93 and 94, respectively, and to recite that injury to the hippocampus is an injury to the dentate gyrus. These amendments derive support at least from col. 8, lines 34-36 and col. 9, lines 11-13 of the patent as issued. Claims 97-102 have been added; these new claims are similar to claims 93 and 94, but instead recite that the area of CNS damage includes the striatum, thalamus, and cortex, respectively. These amendments derive support at least from col. 7, lines 33-36; col. 8, lines 34-36 and col. 9, lines 11-13 of the patent as issued. No new matter has been added.

**Objections under 37 CFR 1.172(a)**

At pages 3-3 of the Official Action, the Examiner asserts that the application is not in compliance with 37 CFR 1.172(a), because the assignee has purportedly “not established its ownership interest in the patent for which reissue is being requested.” Once again, Applicants respectfully disagree.

As discussed in the previous response, there are two inventors of the instant application: Peter Gluckman, and Karoly Nkolics. At the time the Statements under 37 CFR 3.37(b) were

filed on November 1, 2004, Dr. Nickolicks had assigned his rights to Genentech, Inc. (Reel/Frame 015617/0156), while Dr. Gluckman had assigned his rights to Auckland Uniservices Ltd. (Reel/Frame 015618/0583). Copies of these assignment documents are attached hereto.

The Examiner notes that two sets of papers establishing consent of the assignee to the reissue were filed on November 1, 2004. One indicated that Genentech was the owner of the entire right, title, and interest in the patent; the other indicated that Auckland Uniservices was the owner of the entire right, title and interest in the patent. The basis for these ownership claims was that Dr. Nickolicks had assigned all of his rights in the patent to Genentech, while Dr. Gluckman had assigned all of his rights in the patent to Auckland Uniservices. As each inventor is a joint owner of the patent, each inventor owns an undivided 100% interest in the patent. 35 USC 262. *See, MPEP 301*. Accordingly, their assignment of their rights made Genentech and Auckland Uniservices joint owners of the patent, where each owned an undivided 100% interest in the patent.

Since that time, Auckland Uniservices assigned its rights to NeuronZ Ltd. (Reel/Frame 015612/0905). In 2004, NeuronZ Ltd. was acquired by Neuren Pharmaceuticals, Ltd. (see attached Appendix 4E to Neuren's 2004 Preliminary Final Report). In 2007, Neuren Pharmaceuticals, Ltd. assigned its rights in the application to Genentech (Reel/Frame 019110/0928). Accordingly, Genentech is currently the sole assignee/owner of the instant application. Copies of these assignment documents are attached hereto. As Genentech is the sole owner of the rights to the patent, and has already consented to the reissue, it is believed that the consent of the current and correct assignee has been established. Nevertheless, if the

Examiner would like to specify exactly what papers he would like to see added to the file in order to establish the consent of the assignee, every effort will be made to provide them.

### **Objections to the disclosure**

At page 4 of the Official Action, the Examiner objects to the priority claim as amended, because “the recitation that priority to U.S. Patent Application Serial No. 08/460,365 is claimed under 35 U.S.C. 120 is incorrect.” The Examiner further notes that “the first paragraph of the specification also does not recite a relationship, i.e., continuation, divisional, or continuation-in-part, between this application and the ‘365 application, which is another requirement for a claim for priority under 35 U.S.C. 120.” By the present Amendment, the priority claim has been amended to delete reference to 35 U.S.C. 120, thereby rendering this objection moot.

### **Oath and Declaration**

At pages 4-5 of the Official Action, the Examiner asserts that the reissue oath/declaration filed October 3, 2006 is defective, on the basis that it “lacks an acceptable duty to disclose statement.” Applicants respectfully disagree. Nevertheless, without conceding to the Examiner’s arguments, but solely in an effort to expedite prosecution, submitted herewith are replacement Oath & Declaration documents, including a duty to disclose statement which references 37 CFR 1.56 in its entirety. The replacement Oath & Declaration has been signed by Dr. Gluckman. Dr. Nickoliks has expressed his willingness to execute the Declaration; a further copy of the Declaration bearing Dr. Nickoliks’ signature will be provided as soon as it is obtained by Applicants’ undersigned representative.

**Rejections under 35 USC 251**

Claims 78-92 stand rejected under 35 USC 251 as impermissibly broadened over the claims of U.S. Patent 5,714,460. Although Applicants disagree with the Examiner's characterization of these claims as impermissibly broadened, by the present Amendment, they have been deleted without prejudice or disclaimer, thus rendering these rejections moot.

**Rejections under 35 USC 112, ¶1**

Claims 78-92 stand rejected under 35 USC 112, ¶1 as purportedly unsupported by an adequate written description in the specification. Although Applicants disagree with the Examiner's characterization of these claims as not supported by an adequate written description, by the present Amendment, they have been deleted without prejudice or disclaimer, thus rendering these rejections moot.

**Rejections under 35 USC 103**

Claims 78-92 stand rejected under 35 USC 103 as purportedly estopped on the merits by the final judgment in interference No. 104,533; and as purportedly obvious over WO90/14838 and over Gluckman et al. *Biochem Biophys Res Comm* 182:593-599. Although Applicants disagree with the Examiner's characterization of these claims as purportedly obvious, by the present Amendment, they have been deleted without prejudice or disclaimer, thus rendering these rejections moot.

**Rejections under 35 USC 102**

Claims 78, 79, and 81 stand rejected under 35 USC 102(b) as purportedly anticipated by WO90/14838. Although Applicants disagree with the Examiner's characterization of these claims as purportedly anticipated, by the present Amendment, they have been deleted without prejudice or disclaimer, thus rendering these rejections moot.

Claims 78, 79, 84, and 89 stand rejected under 35 USC 102(a) as purportedly anticipated by Gluckman et al. *Biochem Biophys Res Comm* 182:593-599. Although Applicants disagree with the Examiner's characterization of these claims as purportedly anticipated, by the present Amendment, they have been deleted without prejudice or disclaimer, thus rendering these rejections moot.

**Conclusion**

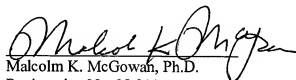
In the event that there are any questions concerning this paper, or the application in general, the Examiner is respectfully urged to telephone Applicants' undersigned representative so that prosecution of the application may be expedited.

The Commissioner is hereby authorized to charge any insufficient fees or credit any overpayment associated with this application to Deposit Account No. 50-4047 (7046529001).

Respectfully submitted,  
BINGHAM MCCUTCHEN, LLP

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